REMARKS

Claims 1-25 are pending and under consideration. Claims 1, 7, 18-22 and 24 are amended herein. Support for the amendments to the claims may be found in the claims as filed originally. Reconsideration is requested based on the foregoing amendment and the following remarks. This amendment is believed to place the application in condition for allowance, and entry therefore is respectfully requested. In the alternative, entry of this amendment is requested as placing the application in better condition for appeal by, at least, reducing the number of issues outstanding. Further reconsideration is requested based on the foregoing amendment and the following remarks.

Response to Arguments:

The Applicants appreciate the consideration given to their arguments. The Applicants, however, are disappointed that their arguments were not found to be persuasive.

The Applicants argued in the response filed September 8, 2005 that in order for NEXPO to anticipate an advertisement preparation unit for preparing an advertisement requested by an advertiser, NEXPO would have to show a person of skill in the art how to make and use an advertisement preparation unit for preparing an advertisement requested by an advertiser. That is, to serve as an anticipating reference, NEXPO must enable the claimed invention.

The response to this argument at pages 7 and 8 of the final Office Action is essentially that since NEXPO uses some words that are similar to those of the claimed invention, NEXPO can anticipate the claimed invention. A reference like NEXPO, however, must meet the same standards of enablement as a U.S. patent in order to be used in a rejection. To put this succinctly, if NEXPO were filed as an application for a patent, the application would not meet the requirements of 35 U.S.C. § 112. NEXPO thus cannot anticipate the claimed invention. Further reconsideration is thus requested.

Objections to the Claims:

Claim 23 was objected to for an informality. Claim 23 is now designated "previously presented," which is submitted to be an accurate identifier of the status of claim 23. Withdrawal of the objection is earnestly solicited.

Claim Rejections - 35 U.S.C. § 112:

Claim 7 was rejected under 35 U.S.C. § 112, second paragraph, as indefinite.. Claim 7 was amended to make it more definite. In particular, the recitation "publicized Web page," is now

simply "Web page" in claim 7, to conform to claim 1 from which it depends. Withdrawal of the rejection is earnestly solicited.

Claim Rejections - 35 U.S.C. § 102:

Claims 1-5, 7-10, 16, and 18-24 were rejected under 35 U.S.C. § 102(b) as anticipated by NAA® Presstime: NEXPO '97 Report (hereinafter "NEXPO"). The rejection is traversed to the extent it would apply to the claims as amended.

The second clause of claim 1 recites:

> A database which registers a supplier for providing a first service and users that have contracts with the supplier.

NEXPO neither teaches, discloses, nor suggests "a database which registers a supplier for providing a first service and users that have contracts with the supplier," as recited in claim 1. The final Office Action seeks to equate the claimed "supplier" with a newspaper publisher at page 3, line 6. This is submitted to be incorrect. According to this interpretation of the NEXPO reference, the newspaper publisher would be registering itself with its *own* database.

NEXPO, rather, is about allowing advertisers to create ads for print, audiotex and the World Wide Web, i.e. a newspaper's relationship with its own *advertisers*. In particular, as described at page 4, second paragraph of NEXPO:

> Gannett Media Technologies International, Cincinnati, serves 20 Gannett newspapers and 30 others with Celebro Advertising Systems. And Associated Information Systems International Inc. of Auburn, Calif., offers Autobase, allowing advertisers to create ads for print, audiotex and the World Wide Web.

Since NEXPO is about a newspaper's relationship with its own advertisers, NEXPO has no interest in, let alone disclosure of, "a database which registers a supplier for providing a first service and users that have contracts with the supplier," as recited in claim 1.

The third clause of claim 1 recites:

> An advertisement preparation unit for preparing an advertisement requested by an advertiser different from said users and for placing said advertisement on a Web page so that said advertisement which is a second service provided as a privilege service pursuant to said first service providing contract is viewed.

NEXPO neither teaches, discloses, nor suggests "an advertisement preparation unit for preparing an advertisement requested by an advertiser different from said users and for placing said advertisement on a Web page so that said advertisement which is a second service

provided as a privilege service pursuant to said first service providing contract is viewed," as recited in claim 1.

The final Office Action seeks to equate the claimed "users" with the advertiser in NEXPO at page 3, line 5. This is submitted to be incorrect. According to this interpretation of the NEXPO reference, the advertisers, as users, are contracting with themselves, as suppliers of advertising, to view their *own* advertisements in order to receive a second service. This makes little sense. Still, in the interest of compact patent prosecution, and not for any reason of patentability, claim 1 has been amended to define an advertiser as being different from a user.

Furthermore, the final Office Action seeks to equate the claimed "second service" with an advertisement at page 3, line 11. This is submitted to be incorrect. According to this interpretation of the NEXPO reference, the advertiser is receiving an opportunity to view their *own* advertisement as a privilege service for viewing their own advertisement.

The fourth clause of claim 1 recites:

> An advertisement utilization unit which, in the case when a user is identified as a contractor user of the first service on the database through the inputted user information, allows the user to view said advertisement on the Web page so as to provide the second service which is the privilege service.

NEXPO neither teaches, discloses, nor suggests "an advertisement utilization unit which, in the case when a user is identified as a contractor user of the first service on the database through the inputted user information, allows the user to view said advertisement on the Web page so as to provide the second service which is the privilege service," as recited in claim 1. An advertiser is different from users, as discussed above, contrary to the interpretation in the final Office Action.

The fifth clause of claim 1 recites:

> Wherein the second service is provided to the user at an independent time and by a different medium from the first service.

NEXPO neither teaches, discloses, nor suggests a "second service that is provided to the user at an independent time and by a different medium from a first service," as recited in claim 1. An advertiser is different from users, as discussed above, contrary to the interpretation in the final Office Action.

Finally, to serve as an anticipating reference the reference must enable that which it is asserted to anticipate.

A claimed invention cannot be anticipated by a prior art reference if the allegedly

> anticipatory disclosures cited as prior art are not enabled." Amgen, Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003). See Bristol-Myers Squibb v. Ben Venue Laboratories, Inc., 246 F.3d 1368, 1374, 58 USPQ2d 150 8, 1512 (Fed. Cir. 2001) ("To anticipate the reference must also enable one of skill in the art to make and use the claimed invention."); PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566, 37 USPQ2d 1618, 1624 (Fed. Cir. 1996) ("To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter."). Elan Pharmaceuticals Inc. v. Mayo Foundation for Medical Education and Research, 68 USPQ2d 1373 (CA FC 2003):

In particular, for NEXPO to anticipate an advertisement preparation unit for preparing an advertisement requested by an advertiser, NEXPO would have to show a person of skill in the art how to make and use an advertisement preparation unit for preparing an advertisement requested by an advertiser. NEXPO does not do this. NEXPO, in fact, doesn't even mention an advertisement preparation unit for preparing an advertisement requested by an advertiser, let alone inform the reader how one might be made and used.

NEXPO, rather, is basically an advertising fluff piece itself, there are very few technical details in it at all. Thus, NEXPO cannot anticipate the claimed invention, since a person of skill in the art would not have been able to discern from NEXPO how to make and use an advertisement preparation unit for preparing an advertisement requested by an advertiser. Claim 1 is submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 3, 4, 5, 7-10, and 16 depend from claim 1 and add additional distinguishing elements. Claims 3, 4, 5, 7-10, and 16 are thus also submitted to be allowable. Withdrawal of the rejection of claims 3, 4, 5, 7-10, and 16 is earnestly solicited.

Claim 2:

> The second clause of claim 2 recites:
>
> A contractor database that registers contractors that have subscriber contracts with a newspaper dealer.

NEXPO neither teaches, discloses, nor suggests "a contractor database that registers contractors that have subscriber contracts with a newspaper dealer," as recited in claim 2. NEXPO, rather, which is written from the point of view of a newspaper's advertisers, mentions no subscribers at all.

> The third clause of claim 2 recites:
>
> An advertisement preparation unit for preparing an advertisement requested by

an advertiser and for placing said advertisement on a web page so as to be viewed.

NEXPO neither teaches, discloses, nor suggests "an advertisement preparation unit for preparing an advertisement requested by an advertiser and for placing said advertisement on a web page so as to be viewed," as discussed above with respect to the rejection of claim 1.

The fourth clause of claim 2 recites:

An advertisement utilization unit which, in the case when a user is identified as a contractor user on the database through the inputted user information, allows the user to view said advertisement on the web page as a privilege service provided under said subscription contract.

NEXPO neither teaches, discloses, nor suggests "an advertisement utilization unit which, in the case when a user is identified as a contractor user on the database through the inputted user information, allows the user to view said advertisement on the web page as a privilege service provided under said subscription contract," as discussed above with respect to the rejection of claim 1.

The fifth clause of claim 2 recites:

The advertisement view is provided to the user at an independent time and by a different medium from a delivery of a newspaper.

NEXPO neither teaches, discloses, nor suggests "the advertisement view is provided to the user at an independent time and by a different medium from a delivery of a newspaper," as discussed above with respect to the rejection of claim 1. Claim 2 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 2 is earnestly solicited.

Claim 18:

The second clause of claim 18 recites:

Registering in a database a supplier for supplying a first service and users having contracts with the supplier.

NEXPO neither teaches, discloses, nor suggests "registering in a database a supplier for supplying a first service and users having contracts with the supplier," as discussed above with respect to the rejection of claim 1.

The third clause of claim 18 recites:

Preparing an advertisement requested from the advertiser different from said

> users and placing the advertisement in a web page so that the advertisement which is a second service provided as a privilege service pursuant to said first service privilege contract is viewed.

NEXPO neither teaches, discloses, nor suggests "preparing an advertisement requested from the advertiser different from said users and placing the advertisement in a web page so that the advertisement which is a second service provided as a privilege service pursuant to said first service privilege contract is viewed" as discussed above with respect to the rejection of claim 1.

The fourth clause of claim 18 recites:

> Allowing in the case when a user is identified as a contractor user of said first service on the database through the inputted user information, the user to view the advertisement on said web page so as to provide said second service which is the privilege service.

NEXPO neither teaches, discloses, nor suggests "allowing in the case when a user is identified as a contractor user of said first service on the database through the inputted user information, the user to view the advertisement on said web page so as to provide said second service which is the privilege service," as discussed above with respect to the rejection of claim 1.

The fifth clause of claim 18 recites:

> The advertisement view is provided to the user at an independent time and by a different medium from a delivery of a newspaper.

NEXPO neither teaches, discloses, nor suggests "the advertisement view is provided to the user at an independent time and by a different medium from a delivery of a newspaper," as discussed above with respect to the rejection of claim 1. Claim 18 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 18 is earnestly solicited.

Claim 19:

The second clause of claim 19 recites:

> Registering in a database a supplier for supplying a first service and users having contracts with the supplier.

NEXPO neither teaches, discloses, nor suggests "registering in a database a supplier for supplying a first service and users having contracts with the supplier," as discussed above with respect to the rejection of claim 1.

The third clause of claim 19 recites:

> Preparing an advertisement requested from the advertiser different from said users and placing the advertisement in a web so that the advertisement which is a second service provided as a privilege service pursuant to said first service privilege contract is viewed.

NEXPO neither teaches, discloses, nor suggests "preparing an advertisement requested from the advertiser different from said users and placing the advertisement in a web so that the advertisement which is a second service provided as a privilege service pursuant to said first service privilege contract is viewed" as discussed above with respect to the rejection of claim 1.

The fourth clause of claim 19 recites:

> Allowing, in the case when a user is identified as a contractor user of said first service on the database through the inputted user information, the user to view the advertisement on said web page so as to provide said second service which is the privilege service.

NEXPO neither teaches, discloses, nor suggests "allowing, in the case when a user is identified as a contractor user of said first service on the database through the inputted user information, the user to view the advertisement on said web page so as to provide said second service which is the privilege service," as discussed above with respect to the rejection of claim 1.

The fifth clause of claim 19 recites:

> The advertisement view is provided to the user at an independent time and by a different medium from a delivery of a newspaper.

NEXPO neither teaches, discloses, nor suggests "the advertisement view is provided to the user at an independent time and by a different medium from a delivery of a newspaper," as discussed above with respect to the rejection of claim 1. Claim 19 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 19 is earnestly solicited.

Claim 20:

The second clause of claim 20 recites:

> Registering at least contractors having subscriber contracts with a newspaper dealer in a database.

NEXPO neither teaches, discloses, nor suggests "registering at least contractors having subscriber contracts with a newspaper dealer in a database," as discussed above with respect to the rejection of claim 1.

The third clause of claim 20 recites:

> Preparing an advertisement requested by an advertiser different from said users and placing it in a web page.

NEXPO neither teaches, discloses, nor suggests "preparing an advertisement requested by an advertiser different from said users and placing it in a web page" as discussed above with respect to the rejection of claim 1.

The fourth clause of claim 20 recites:

> Allowing, in the case when a user is identified as a contractor on the database through the inputted user information, the user to view the advertisement on said web page as a privilege service provided under said subscription contract.

NEXPO neither teaches, discloses, nor suggests "allowing, in the case when a user is identified as a contractor on the database through the inputted user information, the user to view the advertisement on said web page as a privilege service provided under said subscription contract," as discussed above with respect to the rejection of claim 1.

The fifth clause of claim 20 recites:

> The advertisement view is provided to the user at an independent time and by a different medium from a delivery of a newspaper.

NEXPO neither teaches, discloses, nor suggests "the advertisement view is provided to the user at an independent time and by a different medium from a delivery of a newspaper," as discussed above with respect to the rejection of claim 1. Claim 20 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 20 is earnestly solicited.

Claim 21:

The second clause of claim 21 recites:

> Registering in a database a supplier for supplying a first service and users having contracts with the supplier.

NEXPO neither teaches, discloses, nor suggests "registering in a database a supplier for supplying a first service and users having contracts with the supplier," as discussed above with respect to the rejection of claim 1.

The third clause of claim 21 recites:

> Preparing an advertisement requested from the advertiser different from said users and placing the advertisement in a web page so that the advertisement

which is a second service provided as a privilege service pursuant to said first service privilege contract is viewed.

NEXPO neither teaches, discloses, nor suggests "preparing an advertisement requested from the advertiser different from said users and placing the advertisement in a web page so that the advertisement which is a second service provided as a privilege service pursuant to said first service privilege contract is viewed" as discussed above with respect to the rejection of claim 1.

The fourth clause of claim 21 recites:

Allowing, in the case when a user is identified as a contractor user of said first service on the database through the inputted user information, the user to view the advertisement on said web page so as to provide said second service which is the privilege service.

NEXPO neither teaches, discloses, nor suggests "allowing, in the case when a user is identified as a contractor user of said first service on the database through the inputted user information, the user to view the advertisement on said web page so as to provide said second service which is the privilege service," as discussed above with respect to the rejection of claim 1.

The fifth clause of claim 21 recites:

The advertisement view is provided to the user at an independent time and by a different medium from a delivery of a newspaper.

NEXPO neither teaches, discloses, nor suggests "the advertisement view is provided to the user at an independent time and by a different medium from a delivery of a newspaper," as discussed above with respect to the rejection of claim 1. Claim 21 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 21 is earnestly solicited.

Claim 22:

The second clause of claim 22 recites:

Registering at least contractors having subscriber contracts with a newspaper dealer in a database.

NEXPO neither teaches, discloses, nor suggests "registering at least contractors having subscriber contracts with a newspaper dealer in a database," as discussed above with respect to the rejection of claim 1.

The third clause of claim 22 recites:

> Preparing an advertisement requested by an advertiser different from said users and placing the advertisement in a web page.

NEXPO neither teaches, discloses, nor suggests "preparing an advertisement requested by an advertiser different from said users and placing the advertisement in a web page" as discussed above with respect to the rejection of claim 1.

The fourth clause of claim 22 recites:

> Allowing, in the case when a user is identified as a contractor on the database through the inputted user information, the user to view the advertisement on said web page as a privilege service provided under said subscription contract.

NEXPO neither teaches, discloses, nor suggests "allowing, in the case when a user is identified as a contractor on the database through the inputted user information, the user to view the advertisement on said web page as a privilege service provided under said subscription contract," as discussed above with respect to the rejection of claim 1.

The fifth clause of claim 22 recites:

> The advertisement view is provided to the user at an independent time and by a different medium from a delivery of a newspaper.

NEXPO neither teaches, discloses, nor suggests "the advertisement view is provided to the user at an independent time and by a different medium from a delivery of a newspaper," as discussed above with respect to the rejection of claim 1. Claim 22 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 22 is earnestly solicited.

Claim 23:

The fifth clause of claim 23 recites:

> Displaying the advertisement only to the registered users as a privilege.

NEXPO neither teaches, discloses, nor suggests "displaying the advertisement only to the registered users as a privilege," as recited in claim 23.

The sixth clause of claim 23 recites:

> The advertisement view is provided to the user at an independent time and by a different medium from a delivery of a newspaper.

NEXPO neither teaches, discloses, nor suggests "the advertisement view is provided to the user at an independent time and by a different medium from a delivery of a newspaper," as discussed

above with respect to the rejection of claim 1. Claim 23 is submitted to be allowable. Withdrawal of the rejection of claim 23 is earnestly solicited.

Claim 24:

The second clause of claim 24 recites:

> A database which registers a supplier for providing a first service and a user that has a contract with the supplier providing said first service.

NEXPO neither teaches, discloses, nor suggests "a database which registers a supplier for providing a first service and a user that has a contract with the supplier providing said first service," as discussed above with respect to the rejection of claim 1.

The third clause of claim 24 recites:

> An advertisement preparation unit for preparing an advertisement requested by an advertiser different from said users and for placing said advertisement on a web page so that said advertisement, which is a second service provided as a privilege service pursuant to said contract, is available for viewing.

NEXPO neither teaches, discloses, nor suggests "an advertisement preparation unit for preparing an advertisement requested by an advertiser different from said users and for placing said advertisement on a web page so that said advertisement, which is a second service provided as a privilege service pursuant to said contract, is available for viewing" as discussed above with respect to the rejection of claim 1.

The fourth clause of claim 24 recites:

> An advertisement utilization unit which provides the second service by allowing the user to view said advertisement on the web page.

NEXPO neither teaches, discloses, nor suggests "an advertisement utilization unit which provides the second service by allowing the user to view said advertisement on the web page," as discussed above with respect to the rejection of claim 1. Claim 24 is thus believed to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 24 is earnestly solicited.

Claim 25:

Claim 25 was rejected under 35 U.S.C. § 102(b) as anticipated by US Patent No. 5,740,549 to Reilly et al. (hereinafter "Reilly"). The rejection is traversed.

Claim 25 recites:

Displaying the advertisement only to the registered users as a privilege.

Reilly neither teaches, discloses, nor suggests "displaying the advertisement only to the registered users as a privilege," with emphasis added, as recited in claim 25. The final Office Action does not even assert that it does. Claim 25 is thus believed to be allowable. Withdrawal of the rejection of claim 25 is earnestly solicited.

Claim Rejections - 35 U.S.C. § 103:

Claims 6, 11, and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over NEXPO in view of U.S. Published Application 2002/0019768 to Fredrickson (hereinafter "Fredrickson"). The rejection is traversed. Reconsideration is earnestly solicited.

Claims 6, 11, and 17 depend from claim 1 and add additional distinguishing elements. NEXPO neither teaches, discloses, nor suggests "a database which registers a supplier for providing a first service and users that have contracts with the supplier," "an advertisement preparation unit for preparing an advertisement requested by an advertiser different from said users and for placing said advertisement on a Web page so that said advertisement which is a second service provided as a privilege service pursuant to said first service providing contract is viewed," or "an advertisement utilization unit which, in the case when a user is identified as a contractor user of the first service on the database through the inputted user information, allows the user to view said advertisement on the Web page so as to provide the second service which is the privilege service," as discussed above with respect to the rejection of claim 1. Fredrickson does not either, and thus cannot make up for the deficiencies of NEXPO with respect to 6, 11, and 17. Claims 6, 11, and 17 are thus also submitted to be allowable. Withdrawal of the rejection of claims 6, 11, and 17 is earnestly solicited.

Claims 12-15:

Claims 12-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over NEXPO in view of Official Notice. The rejection is traversed. Reconsideration is earnestly solicited.

Claims 12-15 depend from claim 1 and add additional distinguishing elements. NEXPO neither teaches, discloses, nor suggests "a database which registers a supplier for providing a first service and users that have contracts with the supplier," "an advertisement preparation unit for preparing an advertisement requested by an advertiser different from said users and for placing said advertisement on a Web page so that said advertisement which is a second service provided as a privilege service pursuant to said first service providing contract is viewed," or "an

advertisement utilization unit which, in the case when a user is identified as a contractor user of the first service on the database through the inputted user information, allows the user to view said advertisement on the Web page so as to provide the second service which is the privilege service," as discussed above with respect to the rejection of claim 1. The taking of Official Notice does not allege sufficient facts to do so, either, and thus cannot make up for the deficiencies of NEXPO with respect to 12-15.

Official Notice

Furthermore, the Applicants respectfully traverses the Official Notice and demand authority for the statements. The Applicants specifically point out the following errors in the final Office Action.

First, the final Office Action uses common knowledge as the principal evidence for the rejection. As explained in M.P.E.P. § 2144.03(E):

> Any facts so noticed should . . . serve only to 'fill in the gaps' in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.

Second, the noticed fact is not considered to be common knowledge or well-known in the art. In this case, the limitation is not of notorious character or capable of instant and unquestionable demonstration as being well-known. Instead, this limitation is unique to the present invention. *See* M.P.E.P. § 2144.03(A) ("the notice of facts beyond the record which may be taken by the Examiner must be "capable of such instant and unquestionable demonstration as to defy dispute").

Third, there is no evidence supporting the assertion. *See* M.P.E.P. § 2144.03(B) ("there must be some form of evidence in the record to support an assertion of common knowledge").

Fourth, it appears that the rejection is based, at least in part, on personal knowledge. 37 C.F.R. § 1.104(d)(2) requires such an assertion to be supported with an affidavit when called for by the Applicants. Thus, the Applicants call for support for the assertion with an affidavit. Claims 12-15 are thus also submitted to be allowable. Withdrawal of the rejection of claims 12-15 is earnestly solicited.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 1-25 are allowable over the cited references. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 06/1/06

By: _____
Thomas E. McKiernan
Registration No. 37,889

1201 New York Ave, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501